



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

[Handwritten signature]

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/396,701 09/15/99 GUPTA

A MS1-388US

TM02/0117

ALLAN T SPONSELLER
LEE & HAYES PLLC
421 W RIVERSIDE AVENUE
SUITE 500
SPOKANE WA 99201

EXAMINER

PRIETO, B

ART UNIT

PAPER NUMBER

2152

DATE MAILED:

01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/396,701

Applicant(s)

GUPTA ET. AL.

Examiner

Beatriz Prieto

Group Art Unit
2152



☒ Responsive to communication(s) filed on Amendment A, and IDS, 11/20/00

☒ This action is **FINAL**. (b1)

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-6, 8-25, 27-33, and 35-39 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6, 8-25, 27-33, and 35-39 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Detailed Action

1. This office action is in response to amendment A filed on 11/01/00 regarding U.S. Application No. **09/396,701**, where claims **1-6, 8-25, 27-33 and 35-39** remain pending.

Claim Rejections - 35 USC § 103

2. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action:

3. Claims **1-5, 13-16, 25, 27, 31-32 and 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hou et. al. (Hou)** U.S. Patent No. **5,838,313** in view of **Sidana** U.S. Patent No. **6,081,829**.

Regarding claim 1-3, 25 and 29-30, Hou teaches substantial features of the invention as claimed; Hou teaches a system comprising: a client computer (col 6/lines 38-51) to playback multimedia content (col 8/lines 1-15, col 6/lines 30-37) and annotations corresponding to different temporal portions of the multimedia content (col 6/lines 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14); maintaining an annotation database (Fig. 9, 33, col 6/lines 12-14) having a plurality of annotations (col 3/lines 54-col 4/line 25) corresponding to the multimedia content (col 6/lines 38-41), provide the plurality of annotations to the client computer for playback (Fig. 6, playback means, Fig. 12, lines 56-61, col 6/lines 23-25, display annotations means, col 8/lines 43-48), send electronic mail messages (col 3/lines 8-13, create or reply means: col 2/lines 25-37, sending and displaying mail: col 11/lines 22-25, creating e-mail message: col 6/lines 14-16) including annotations (col 11/lines 3-25, Fig. 1) to recipients identified by the client computer (col 4/lines 26-31, Fig. 4), via interface means to receive input data regarding new annotation corresponding to media content (col 6/lines 26-51), generate new annotations create or reply means (col 2/lines 25-37, col 3/lines 9-13) based on received electronic mail messages (col 4/lines 10-14, Fig. 2), and add the new annotations (col 9/lines 15-32, col 1/lines 17-20, adding annotations means: col 5/lines 29-52, report: col 6/lines 10-14, Fig. 3, saving in database) to the annotation database, wherein generate new annotation based on electronic mail message received both in response to the sent electronic mail messages and not in response to the sent electronic mail messages (Hou: col 2/lines 25-30, col 50-col 3/line 13, col 3/line 65-col 4/line 14, col 4/lines 26-31, col 6/lines 14-16), identifier of a temporal range of the media content that the new annotation content is associated with, which corresponds to a location of the media content that is after the beginning of the media content and at which rendering of the media content should begin in response to

meets
Limitation

selection of the identifier of the media content in the electronic mail message; (Hou: col 6/lines 61-66, col 7/lines 1-3, col 8/line 61-63, col 9/lines), wherein said identifier of a temporal segment of the multimedia content is after the beginning of the multimedia content; Hou teaches means for identifying temporal ranges or segment of multimedia content with which the new annotation is associated, such as time temporal range denoting the a segment of time (i.e. beginning/end), temporal range of information denoting the content, range, category type, beginning and end of a segmented multimedia content supporting means to store, retrieve, render multimedia content (e.g. load/display, time, object identifier#), move, time, object#, at the begin/end of other objects), annotation sets corresponding to the multimedia categories (e.g. image, text, audio), that the new/stored annotation is part of (Hou: Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51), wherein generate new annotation based on electronic mail message received both in response to the sent electronic mail messages and not in response to the sent electronic mail messages (Hou: col 2/lines 25-30, col 50-col 3/line 13, col 3/line 65-col 4/line 14, col 4/lines 26-31, col 6/lines 14-16)

however Hou does not explicitly teach where coupled to the client computer to maintain an annotation database and to manage streaming the multimedia content to the client computer is particularly an annotation media server computer, where further an identifier of the media content to which the new annotation corresponds.

Sidana teaches a system/method for enabling client using an user interface to be presented with web-viewable documents including annotations maintaining a annotation multimedia server computer coupled to the client for streaming the multimedia to the client computer (see Sidana: abstract, col 2/lines 34-59), disclosing a system wherein a client computer is provided with annotations corresponding to multimedia content, where annotation media server coupled to the client computer is coupled to an annotation server via a network (see Sidana: col 4/lines 14-33, Fig. 1, element 106, 110, 130, annotation server 120, col 2/lines 41-59, col 4/lines 20-31), where an identifier, identifiers the media content associated with new annotation content (see Sidana: col 8/lines 5-12).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to modify Hou's system with means where an annotation server, coupled to the client computer to maintain an annotation database and to manage streaming the multimedia content to the client computer as taught by Sidana, motivation would be enable the user via multimedia content identifiers to select for viewing or not a annotation included in a document, access a media server to obtain multimedia content corresponding to the content identifier which may further be presented in hierarchical for, where and annotation set identifier one or more sets of annotations.

Regarding claim 4, the combined teachings of Hou and Sidana as discussed above, wherein the client computer is further present an electronic mail message including a multimedia content identifier to a user (Hou: annotations identifiers col 6/lines 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14), receive a user selection of the multimedia content identifier, access a media server to obtain the multimedia content (Sidana: col 7/lines 62-col 8/line 26, Hou: col 11/lines 26-34, playback the multimedia content to the user).

Regarding claim 5, the combined teachings of Hou and Sidana as discussed above, further transmit, to the media server, an identifier of a temporal segment of the multimedia content, and wherein the media server is to stream to the client computer the multimedia content beginning with the identified temporal segment (Hou: col 6/lines 61-66, col 7/lines 1-3, col 8/line 61-63, col 9/lines), wherein said identifier of a temporal segment of the multimedia content is after the beginning of the multimedia content; Hou teaches means for identifying temporal ranges or segment of multimedia content with which the new annotation is associated, such as time temporal range denoting the a segment of time (i.e. beginning/end), temporal range of information denoting the content, range, category type, beginning and end of a segmented multimedia content supporting means to store, retrieve, render multimedia content (e.g. load/display, time, object identifier#), move, time, object#, at the begin/end of other objects), annotation sets corresponding to the multimedia categories (e.g. image, text, audio), that the new or stored annotation is part of (Hou: Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51).

Regarding claim 13, and 16, the combined teachings of Hou and Sidana as discussed above, the method/program (Sidana: col 1/lines 55-62) teach receiving data for a new annotation corresponding to a temporal range (Hou: col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14) of media content (Hou: col 1/lines 39-44, col 3/lines 9-13); generating an electronic mail message including both the content of the new annotation and an identifier of the media content (Hou: create electronic mail messages col 3/lines 8-13, create means: col 2/lines 25-37, col 3/lines 9-13, via interface means to receive input data regarding new annotation corresponding to media content col 6/lines 26-51, containing media content identifiers such as temporal range markers col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14, col 1/lines 39-44); and forwarding the electronic mail message to a recipient identified by the data (Hou: sending/displaying mail: col 11/lines 22-25, col 6/lines 14-16 including annotations col 11/lines 3-25, Fig. 1).

Regarding claim 14, the combined teachings of Hou and Sidana as discussed above, wherein the generating further comprises including, in the electronic mail message, an identifier of the new annotation (Sidana: col 8/lines 5-12).

Regarding claim 15, the combined teachings of Hou and Sidana as discussed above, wherein the generating further comprises including, in the electronic mail message, an identifier of the temporal range of media content (Hou: col 8/lines 61-63, col 9/lines 1-4, col 6/lines 61-66, col 7/lines 1-3).

Regarding claim 27, the combined teachings of Hou and Sidana as discussed above, wherein the electronic mail message further includes a unique identifier of the new annotation (Sidana: col 7/lines 62-col 8/line 26).

Regarding claim 28, the combined teachings of Hou and Sidana, wherein the electronic mail message further includes an identifier of one or more of a plurality of annotation sets, corresponding to categories for annotations, that the new annotation is associated

with (Hou: col 5/lines 10-28, Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51).

Regarding claim 31, the combined teachings of Hou and Sidana as discussed above, a method comprising: receiving an electronic mail notification of an annotation corresponding to media content (Hou: col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14) of media content col 1/lines 39-44, col 3/lines 9-13, receiving an electronic mail message including both the content of the new annotation and an identifier of the media content create electronic mail messages col 3/lines 8-13, col 2/lines 25-37, containing media content identifiers/temporal range markers col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14, col 1/lines 39-44); and replying to the electronic mail notification to generate a new annotation corresponding to the media content (Hou: reply means: col 2/lines 31-37), including, in the reply, an identifier of one or more annotation sets that the new annotation is associated with;*(Sidana: col 7/lines 62-col 8/line 26, Hou: col 5/lines 10-28, Figs. 6, 14-15, col 7/lines 1-51, col 2/lines 25-37, 52-61, col 6/lines 10-66, col 3/lines 8-13, col 8/lines 61-63, col 9/lines 9-14, col 1/lines 39-44, col 11/lines 3-25, Fig. 1), displaying a default, corresponding to the identified one or more annotation sets, that is to receive and electronic mail notification of the new annotation; (Goodhand: col 43/line 5-col 44/line 18, Hou: col 4/lines 26-31, Fig. 4).

Regarding claim 32, the combined teachings of Hou and Sidana as discussed above, wherein the replying includes: obtaining, from the electronic mail notification (Goodhand: col 1/lines 26-40), an identifier of the annotation; and including the identifier of the annotation in the reply (Hou: col 5/lines 10-28).

Regarding claim 37, the combined teachings of Hou and Sidana as discussed above, one or more computer-readable media having stored thereon a computer program that, when executed by one or more processors, causes the one or more processors to perform functions including: receiving an electronic mail message; and extracting both annotation content and annotation identification information from the electronic mail message (Hou: col 11/lines 26-34), wherein generate new annotation based on electronic mail message received both in response to the sent electronic mail messages and not in response to the sent electronic mail messages (Hou: col 2/lines 25-30, col 50-col 3/line 13, col 3/line 65-col 4/line 14, col 4/lines 26-31, col 6/lines 14-16). ^{1 2/line}

Regarding claim 38, the combined teachings of Hou and Sidana as discussed above, wherein the computer program further causes the one or more processors to perform functions including: creating a new annotation based on the extracted annotation content and the annotation identification information (Hou: col 5/lines 5-28); and adding the new annotation to an annotation database (Hou: add the new annotations col 9/lines 15-32, col 1/lines 17-20, adding annotations means: col 5/lines 29-52, report: col 6/lines 10-14, Fig. 3, saving in database) to the annotation database, Sidana software program implementation: col 1/lines 55-62).

Regarding claim 39, the combined teachings of Hou, and Sidana as discussed above, wherein the extracting annotation identification information comprises extracting from

the email message: an identifier of media content to which the annotation content corresponds and of a temporal segment (Hou: identifier of a temporal segment of the multimedia content, and wherein the media server is to stream to the client computer the multimedia content beginning with the identified temporal segment, col 6/lines 61-66, col 7/lines 1-3, col 8/line 61-63, col 9/lines), corresponding to the annotation content, of the media content; and an identifier of an annotation set that a new annotation including the extracted annotation content is to be part of (Hou: col 5/lines 5-28), wherein the annotation set is one of one or more annotation sets corresponding to categories for annotations (Hou: Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51).

4. Claims 6, 8-12, 17-24 and 33, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hou-Sidana** in view of **Goodhand et. al. (Goodhand)** U.S. Patent No. 5,923,848 in further view of **Russell et. al. (Russell)** U.S. Patent No. 5,526,407.

Regarding claim 6, and 12, the combined teachings of Hou and Sidana as discussed above, method comprising presenting, to a user, a user interface (Hou: Fig. 5, col 2/lines 62-col 3/line 14, canvas, col 4/lines 32-col 5/lines) allowing the user to create a new annotation (Hou: col 2/lines 52-56, adding/generating means: col 6/lines 10-37) corresponding to media content (Hou: Fig. 5); and including, as part of the user interface (Hou: abstract: col 1/lines 65-col 2/line 5), a field via which the user can identify a recipient that is to receive an electronic mail notification of the new annotation (Hou: col 4/lines 26-32, Fig. 4, 12, Sidana software program implementation: col 1/lines 55-62), and wherein generate new annotation based on electronic mail message received both in response to the sent electronic mail messages and communicated as an electronic message that is not in response to the another electronic mail messages (Hou: col 2/lines 25-30, col 50-col 3/line 13, col 3/line 65-col 4/line 14, col 4/lines 26-31, col 6/lines 14-16), the new annotation to annotation server (see Sidana: abstract, col 2/lines 34-59, col 4/lines 14-33, Fig. 1, (106, 110, 130), annotation server 120, col 2/lines 41-59, col 4/lines 20-31, where an identifier, identifies the media content associated with new annotation content (see Sidana: col 8/lines 5-12)

However Hou nor Sidana explicitly teach where field via which the user can identify a recipient that is to receive an electronic mail of the new annotation consisting of particularly an electronic mail notification

Electronic mail notification is deemed an inherent feature in the combined teachings of Hou and Sidana, where Hou's electronic mail system comprises a standard e-mail system and Sidana's annotation media server has also e-mail capabilities, e-mail systems as know in the art have means for notifying the recipient of the arrival of incoming mail, as taught by Goodhand;

Goodhand discloses where field via which the user can identify a recipient that is to receive an electronic mail of the new annotation consisting of particularly an electronic mail notification (col 1/lines 26-40), disclosing an improvement over existing standard e-mail system (col 8/lines 37-58), comprising means for a client computer to present/display electronic mail messages including annotations (attachments) to recipients identified by the client computer, including as part of the a user interface, a

field via which the user can identify a recipient that is to receive an electronic mail message and notification comprising a new annotation (col 2/lines 18-25, 46-53, col 5/lines 1-11, col 60/lines 67, col 16/lines 40-61), computer-readable memories containing a computer program that is executable by a processor to perform the method (col 39/lines 66-col 40/line 14).

However neither Hou nor Sidana explicitly teach where an installation option that identifies an installation program that can be used to install one or more modules allowing the content and corresponding media content to be rendered .

Russell teaches a system/method related to for capturing, categorizing, and organizing by categories by using temporal segment identifiers of the media content, managing and retrieving multimedia (combined integrated media: audio, video text, graphics, etc. information) (see Russell: col 1/line 22-col 2/line 36, teaching means for annotating text to voice media content, col 3/lines 3-26, col 5/line 57-col 6/line 36, 45-col 7/line 16, identifiers of temporal segments of the multimedia content that are after the beginning of the multimedia content: col 10/line 60-col 11/line 34, col 11/line 65-col 12/line 16, col 13/lines 3-31, 57-64), disclosing installation option that identifies an installation program that can be used to install one or more modules allowing the content and corresponding media content to be rendered (col 16/lines 47-col 19/line 35).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the combined teachings of Hou and Sidana as discussed with means for field via which the user can identify a recipient that is to receive an electronic mail notification of the new annotation, as essentially taught by Goodhand, motivation would be to further enhance existing e-mail system with means for enabling recipient names to be resolved while user is composing a e-mail message without user intervention, enabling user to select from a list field adding the notification means level of urgency of the received message. Further modifying existing system with means for having an installation option that identifies an installation program that can be used to install one or more modules allowing the content and corresponding media content to be rendered, as taught by Russell, motivation would be to enhance existing annotation/playback-based system with of replaying annotated multimedia content in a significantly order that which the media was originally stored, where temporal markers enable the support the enhancement of a playback that will require less time to render media content and enables the user to navigate through the media content by using visual cues.

Regarding claim 8, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, including in the electronic mail message, an indication of an annotation set corresponding to the media content of the new annotation; (Hou: col 3/lines 8-13, col 2/lines 25-37, col 3/lines 9-13, col 6/lines 26-51, col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14, col 1/lines 39-44, sending/displaying mail: col 11/lines 22-25, col 6/lines 14-16, col 11/lines 3-25, Fig. 1).

Regarding claim 9, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, further comprising: allowing the user to identify, via the field of the user interface, a plurality of recipients to receive the electronic mail notification (Goodhand: col 1/lines 36-40, col 16/lines 40-61, col 17/lines 6-37); and forwarding, to each of the

plurality of recipients, the electronic mail notification of the new annotation (Hou: col 4/lines 26-31, Fig. 4).

Regarding claim 10, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, further comprising: allowing the user to input, via the field of the user interface, a group identifier (Goodhand: identifiers set of recipients (list): col 43/line 5-col 44/line 18, Hou: col 4/lines 26-31); identifying an electronic mail address for each of a plurality of recipients corresponding to the group identifier; and forwarding, to each of the plurality of recipients (Hou: col 4/lines 26-31, Fig. 4), the electronic mail notification of the new annotation.

Regarding claim 11, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, further comprising: presenting, as part of the user interface, a default set of recipients to receive the electronic mail notification (Goodhand: identifiers set of recipients (list): col 43/line 5-col 44/line 18, Hou: col 4/lines 26-31).

Regarding claim 17, 18, 20-21, and 23, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, teach means for receiving an electronic mail notification of a new annotation corresponding to media content, the media content having a plurality of temporal segments (Hou: col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14) of media content col 1/lines 39-44, col 3/lines 9-13, receiving an electronic mail message including both the content of the new annotation and an identifier of the media content create electronic mail messages col 3/lines 8-13, col 2/lines 25-37, containing media content identifiers/temporal range markers col 6/line 61-66, col 7/lines 1-3, col 8/lines 61-63, col 9/lines 9-14, col 1/lines 39-44); displaying/presenting the electronic mail notification to a user (Hou: display annotations means, col 8/lines 43-48, sending and displaying mail: col 11/lines 22-25); receiving a user input to access the plurality of media content; and accessing, upon receiving the user input, a media server to stream one of the plurality of segments that corresponds to the new annotation to the user (Sidana: displaying means ; col 4/lines 14-43, accessing via user input: col 5/lines 58-col 6/line 6, col 7/lines 62-col 8/line 26, wherein user input comprises the selection of a URL of the media content identifier), wherein said identifier of a temporal segment of the multimedia content is after the beginning of the multimedia content is associated with; Hou teaches means for identifying temporal ranges or segment of multimedia content with which the new annotation is associated, such as time temporal range denoting the a segment of time (i.e. beginning/end), temporal range of information denoting the content, range, category type, beginning and end of a segmented multimedia content to support means to store, retrieve, render multimedia content (e.g. load/display, time, object identifier#), move, time, object#, at the begin/end of other objects), annotation sets corresponding to the multimedia categories (e.g. image, text, audio), that the new/stored annotation multimedia content is part of (Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51).

Regarding claim 19, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, wherein the presenting comprises: displaying annotation content for the new annotation to the user; and displaying at least one identifier to the user, the at least

one identifier including one or more of a content identifier that identifies the media content; a range identifier that identifies a temporal range of the segment corresponding to the new annotation (Sidana: in the electronic mail message, an identifier of the new annotation, col 8/lines 5-12, an identifier of the temporal range of media content Hou: col 8/lines 61-63, col 9/lines 1-4, col 6/lines 61-66, col 7/lines 1-3), an annotation identifier that identifies the new annotation; and an annotation set identifier that identifies one or more annotation sets that the new annotation is part of (Hou: col 5/lines 10-28); wherein said identifier of a temporal segment of the multimedia content is after the beginning of the multimedia content; Hou teaches means for identifying temporal ranges or segment of multimedia content with which the new annotation is associated, such as time temporal range denoting the a segment of time (i.e. beginning/end), temporal range of information denoting the content, range, category type, beginning and end of a segmented multimedia content supporting means to store, retrieve, render multimedia content (e.g. load/display, time, object identifier#), move, time, object#, at the begin/end of other objects), annotation sets corresponding to the multimedia categories (e.g. image, text, audio), that the new or stored annotation is part of (Figs. 6, 14-15, col 7/lines 4-51, col 2/lines 52-61, col 6/lines 10-14, col 7/line 4/line 51).

Regarding claim 22, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, wherein the receiving a user input comprises receiving a user selection of an identifier of the annotation (Hou: col 6/lines 61-66, col 7/line 1-3).

Regarding claim 24, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, one or more computer-readable media as recited in claim 23, wherein the user-selectable identifier comprises a uniform resource locator (URL) that identifies a server and a location at the server where the media content is located (Sidana: col 7/lines 62-col 8/line 26).

Regarding claim 33, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, teach means/method comprising: receiving an electronic mail thread including a plurality of electronic mail messages (Goodhand: col: 4/lines 1-11, group of messages and replies related by topic, means for organizing received mail thread: col 4/lines 40-43); creating a plurality of annotation from at least one of the electronic mail messages in the electronic mail thread (Hou: generating an electronic mail message including both the content of the new annotation and an identifier of the media content, create electronic mail messages col 3/lines 8-13, create means: col 2/lines 25-37, col 3/lines 9-13); and adding a plurality of annotation to an annotation database (Hou: add the new annotations, col 9/lines 15-32, col 1/lines 17-20, adding annotations means: col 5/lines 29-52, report: col 6/lines 10-14, Fig. 3, saving in annotation database).

Regarding claim 35, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, wherein: the creating comprises generating, for each of the plurality of electronic mail messages, an annotation (Hou: generating an electronic mail message including both the content of the new annotation and an identifier of the media content, create electronic mail messages col 3/lines 8-13, create means: col 2/lines 25-37, col 3/lines 9-13); and the adding comprises adding each of the generated annotations to the annotation database (Hou: add the new annotations, col 9/lines 15-32, col 1/lines 17-20,

adding annotations means: col 5/lines 29-52, report: col 6/lines 10-14, Fig. 3, saving in annotation database).

Regarding claim 36, the combined teachings of Hou, Sidana, Goodhand and Russell as discussed above, further comprising locating, in the electronic mail thread, an identifier of media content that the annotation corresponds to (Sidana: mail message further includes a unique identifier of the new annotation, col 7/lines 62-col 8/line 26, wherein the electronic mail message further includes an identifier of one or more annotation sets that the new annotation is associated with, Hou: col 5/lines 10-28).

Response to Arguments

5. Regarding claim 1, applicant argues (A): prior art of record Hou does not teach claim limitation as amended, asserting Hou teaches sending a report including annotation to a receiver, and making a new annotation which is reply to a selected segment of another annotation, however does not teach as amended limitation recites: "generate new annotation based on electronic mail messages received both in response to the sent electronic mail messages and not in response to the sent electronic mail messages".

6. Regarding claim 2, applicant argues (B): prior art of record Sidana does not teach claim limitation, i.e. "a media server to manage streaming the multimedia content to the client computer", asserting that the disclosure of an HTML web document transferable between a client and server where the retrieved document is displayable by the client browser on the screen does not suggest a media server streaming multimedia content to the client; where streaming is to be interpret as meaning data representing various media types being provided over a network to a client computer on a real-time, as-needed bases, rather than pre-delivered in its entirety before playback, making reference to specification (page 2, lines 14-18).

7. Regarding claims 5, 13, 25, 28, 31, 39, 6, 17, 19, and 23, presented on pages 13-21, are all arguments directed to claim limitations as amended, wherein amended limitations have above modified above and addressed accordingly.

8. Regarding claim 33, applicant argues, (C) prior art of record Hou, Sidana nor Goodhand teach claim limitation as amended: "creating a plurality of annotations from the plurality of electronic mail messages in the electronic mail thread";

9. In response to point (A): Hou teaches generate a new annotation based on electronic mail messages received both in response to the sent electronic mail message and not in response to the sent electronic mail messages: (see Hou; col 2/lines 25-30, col 50-col 3/line 13, col 3/line 65-col 4/line 14, col 4/lines 26-31, col 6/lines 14-16).

10. In response to point (B): (i) Sidana teaches a media server configured to manage streaming the multimedia content to the client computer (Sidana: abstract, col 2/lines 34-59, col 4/lines 14-33, Fig. 1, element 106, 110, 130, annotation server 120, col 2/lines 41-

59, col 4/lines 20-31, where an identifier, identifies the media content associated with new annotation content, col 8/lines 5-12), (ii) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a media server to manage streaming the multimedia content to the client computer, where streaming is to be interpret as meaning data representing various media types being provided over a network to a client computer on a real-time, as-needed bases, rather than pre-delivered in its entirety before playback"), are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. In response to point (C):

(i) According to applicant's specification, email application used as the basis of claimed invention is a convention e-mail application, having typical user-selectable features (Figs. 8-9, (e.g. 300, 316, 318)), such as viewing, creating, manipulating (e.g. replying, creating a new), wherein typical email applications provide a user to a forward option that allows the user to send a received email message to one or more other users, optionally appending an additional message by the user, such email messages can be forward from user to user, creating a string of mail messages often referred to as an "email thread", wherein such forwarding can be found in numerous settings, such as designers that carry on "conversations" or discuss various options with one another (see page 26-34, line 5).

(ii) claim recites *receiving an electronic mail thread including a plurality of electronic mail messages* (Goodhand: col: 4/lines 1-11, group of messages and replies related by topic, means for organizing received mail thread: col 4/lines 40-43, Fig. 6-7, 11, 16, 19, 26 and 28, forward/receiving to/from multiple users means: col 1/lines 64-col 2/line 8, col 24/lines 18-25); *creating a plurality of annotation* (Hou: col 1/lines 6-10, 37-44, col 2/lines 31-37, 50-61, col 6/lines 26-37) *from the plurality of electronic mail messages in the electronic mail thread* (Hou: generating an electronic mail message including both the content of the new annotation and an identifier of the media content, create electronic mail messages col 3/lines 8-13, create means: col 2/lines 25-37, col 3/lines 9-13, Goodhand: col: 4/lines 1-11, group of messages and replies related by topic, means for organizing received mail thread: col 4/lines 40-43, Fig. 6-7, 11, 16, 19, 26 and 28, forward/receiving to/from multiple users means: col 1/lines 64-col 2/line 8, col 24/lines 18-25); *and adding a plurality of annotation to an annotation database* (Hou: add the new annotations, col 9/lines 15-32, col 1/lines 17-20, adding annotations means: col 5/lines 29-52, report: col 6/lines 10-14, Fig. 3, saving in annotation database).

12. Applicant's presented arguments, filed 11/01/00 have been fully considered but are not deemed to be persuasive.


13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action. **THIS ACTION IS MADE FINAL**.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Beatriz Prieto** whose telephone number is **(703) 305-0750**. The Examiner can normally be reached on Monday-Friday from 6:30 to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, **Mark H. Rinehart** can be reached on **(703) 305-4815**. The fax phone number for the organization where this application or proceeding is assigned is **(703) 305-9731**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703) 305-3900**.



B. Prieto
Patent Examiner
January 9, 2001


LE HIEN LUU
PRIMARY EXAMINER